

REMARKS

Claims 56-60 are currently pending in the application. Claims 61-65 have been cancelled without prejudice. Claim 57 has been amended. The amendments find support in the specification and are discussed in the relevant sections below. No new matter is added.

Priority

Applicant has corrected the updated priority information in the first paragraph of the application with the current status. Support for the additional priority document is found on page one of the specification as originally filed, and on the filing receipt.

Claim Rejections – 35 USC § 112

Claims 61-65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Office action further states that “This rejection is a new matter rejection”.

The Office Action states that the specification as originally filed does not disclose any antibody which binds to a polypeptide consisting of at least four contiguous amino acid residues of the sequence of residues 185-215 of SEQ ID NO:6, nor an antibody which binds to a polypeptide encoded by at least 12 contiguous nucleic acid residues of a sequence comprising residues 792 to 884 of SEQ ID NO:3, wherein said polypeptide has the same reading frame as the sequence of SEQ ID NO:6.

While not necessarily acquiescing to the rejection, and solely for the purposes of advancing prosecution, Applicant has canceled claims 61-65 without prejudice.

102 Rejection

Claims 56, 58, 60-61, 63 and 65 are rejected under 102(e) as being anticipated by Li et al. (USPN 6,025,154).

Claims 61, 63 and 65 have been cancelled as detailed above.

Applicant traverses the rejection of claims 56, 58 and 60 on the grounds that the cited art does not teach each and every limitation recited in the instant claims.

Applicants submit that for a determination of anticipation to be proper, the prior art reference must disclose each and every limitation of the claim. *Atlas Powder Company et al. v. IRECO, Incorporated et al.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999).

The Office Action states that:

“Li et al describe a human chemokine receptor polypeptide of SEQ ID NO:2. It also describes antibodies against the receptor (column 2, lines 65-68 and column 16, lines 45-65). The receptor polypeptide of SEQ ID NO:2 is 97.8% identical to SEQ ID NO:6 of the instant invention amino acids 1-184 (see Appendix A). Thus antibodies that comprise amino acid residues 185 to 215 of SEQ ID NO:6 could also bind to polypeptide of the instant invention (SEQ ID NO:2). Therefore, claims 56, 58, 60, 61, 63 and 65 are rejected under 102(e) as being anticipated by Li et al. (USPN 6,025,154).”

With regard to the sentence “The receptor polypeptide of SEQ ID NO:2 is 97.8% identical to SEQ ID NO:6 of the instant invention amino acids 1-184 (see Appendix A)”, Applicant is interpreting as meaning that ‘The receptor polypeptide of SEQ ID NO:2 is 97.8% identical to amino acids 1-184 of SEQ ID NO:6 of the instant invention’. Applicant found no Appendix A was attached to the Office Action, however Applicant assumes that said appendix was a sequence listing showing 97.8% sequence identity between amino acid residues 1-184 of instant SEQ ID NO:6 and amino acid residues SEQ ID NO:2 taught by Li et al.

With regard to the sentence “Thus antibodies that comprise amino acid residues 185 to 215 of SEQ ID NO:6 could also bind to the polypeptide of the instant invention (SEQ ID NO:2)”, emphasis added, Applicant is interpreting as meaning that “Thus antibodies directed to a polypeptide that comprises amino acid residues 185-215 of SEQ ID NO:6 could also bind to the polypeptide of Li’s invention (SEQ ID NO:2)”.

Li et al. does not teach a polypeptide that comprises amino acid residues 185-215 of SEQ ID NO:6, nor does Li et al. teach an antibody which binds to a polypeptide that comprises amino acid residues 185-215 of SEQ ID NO:6 as required by instant Claim 56 and its dependent claim 60.

Li et al does not teach a polypeptide encoded by a nucleic acid comprising residues 792 to 884 of SEQ ID NO: 3, wherein said polypeptide has the same reading frame as the sequence of SEQ ID NO: 6, nor does Li et al. teach an antibody which binds to said polypeptide, as required by instant claim 58 and its dependent claim 60.

Because the cited prior art does not teach each and every claim limitation, specifically the recited polypeptides to which the claimed antibodies are directed, Applicant contends that the prior art is not anticipatory. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Allowed Claims

The Office Action states that Claims 57 and 59 are allowable. However, the Office Action also states that the disclosure is objected to because the specification lacks antecedent basis for claims 57 and 59, and that the specification needs to be amended to refer to the claimed subject matter, see page 8, last paragraph.

Page 8, last paragraph, discloses:

“Advantageously, said antibody is a monoclonal antibody which is preferably directed to an epitope of the peptide according to the invention and present on the surface of a cell expressing said peptide.”

Applicant contends that newly amended Claim 57 recites “An antibody which binds to a polypeptide consisting of amino acid residues SEQ ID NO:13”. Support for said amendment is found in Figure 6B. Figure 6B displays SEQ ID NO:13 (identical to residues 182-215 of SEQ ID NO:6), and as such the peptide consisting of SEQ ID NO:13 is a peptide of the invention. Applicant notes that the referenced paragraph on page 8 discloses an antibody directed to an epitope of the peptide according to the invention, and therefore provides support for newly amended Claim 57.

Applicant also contends that claim 59 which recites “An antibody which binds to a polypeptide encoded by a nucleic acid consisting of residues 792 to 884 of SEQ ID NO: 3, wherein said polypeptide has the same reading frame as the sequence of SEQ ID NO: 6”, also is supported by Figure 6B in the specification. Figure 6B displays the nucleotide sequence which encodes a polypeptide consisting of SEQ ID NO:13, a peptide of the invention. Applicant notes that the referenced paragraph on page 8 discloses an antibody directed to an epitope of the peptide according to the invention, and therefore provides support for newly amended Claim 59.

At the request of the Office Action, Applicant has amended the specification by adding the following sentence following the final sentence of said referenced paragraph: “An antibody which binds to a polypeptide encoded by a nucleic acid consisting of residues 792 to 884 of SEQ ID NO: 3, wherein said polypeptide has the same reading frame as the sequence of SEQ ID NO: 6”. For the reasons discussed above, Applicant contends that no new matter is added by said amendment. Applicant contends that both Claims 57 and 59 now find antecedent basis in the specification, and respectfully request withdrawal of the objection to the specification.

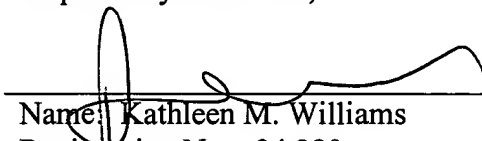
Conclusion

Applicant submits that all claims are allowable as written and respectfully request early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicant's attorney/agent would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney/agent of record.

Respectfully submitted,

Date:

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